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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,959	09/24/2003	Fabio Giannetti	300205054-2	1492

22879 7590 06/29/2007
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EXAMINER

HUYNH, CONG LAC T

ART UNIT	PAPER NUMBER
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2178

MAIL DATE	DELIVERY MODE
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06/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/668,959

Applicant(s)

GIANNETTI ET AL.

Examiner

Cong-Lac Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/24/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: the application filed on 9/24/03, and the IDSs filed on 9/24/03, priority filed 9/24/02.
2. Claims 1-28 are pending in the case. Claims 1, 8-11, 13, 15, 20-22, 25-28 are independent claims.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 23-24, 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 23 and 24, which are dependent on claims 1 and 23 respectively, it is unclear what Applicant would like to claim since claims 23 and 24 are device claims whereas claim 1 is a method claim. Claim 23 is rejected, and thus, its dependent claims 24 and 28 are also rejected due to their dependency.

7. Claims 12, 16, 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 12, 16, 17 recite the limitation "the initial portion" in line 2. There is insufficient antecedent basis for this limitation in the claims.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claim 11 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/349,668. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application has the limitations:

- adapting the authored data to generate at least a preferred and an alternative adapted version of the authored data *to make the data suitable for manifestation on a given class of device*
- delivering the adapted data augmented with the dynamically generated data to at least one data-handling device

but does not have:

- filtering out elements of the content, wherein the filtering step removes elements of content which is not capable of manifestation on the given class of device

However, it is clearly understandable that making the data suitable for manifestation on a given class of device means that the data that is not suitable for manifestation on a given class of device would be removed. Also, it would have been obvious to an ordinary skill in the art at the time of the invention was made to have modified the '668 to incorporate the delivering step since both are directed to a method of *disseminating media content*. The adapted data, after augmented with dynamic content must be delivered to a client device.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

11. Claim 16 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 12. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

12. Applicant is advised that should claim 12 be found allowable, claim 16 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

14. Claims 1-7, 9, 11-12, 16-21, 23-28 are rejected under 35 U.S.C. 102(a) as being anticipated by Brid et al. (US 2002/0143822, 10/3/02, filed 1/31/01).

Regarding independent claim 1, Brid discloses:

- structuring an initial portion of the data to provide at least a preferred and an alternative versions of the initial portion of the data, each version suitable to make the data suitable for handling by at least one of the at least two data-handling devices ([0008], [0025]: different template versions are structured to make data suitable to different devices where each template is considered an initial portion of data since the requested data is provided based on each template)
- storing the versions of the initial portions of the data ([0007], [0025], [0029]: caching the template versions)
- upon receipt of a request for data, adapting one of the preferred or alternative version of the initial portions of the data by augmenting the initial portion of the data with dynamically generated data and delivering the initial portion of the data augmented with the dynamically generated data to at least one data-handling

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device ([0009]-[0010], [0012], [0029], [0035]: retrieving data from the data source and generating data for display on the identified device type from the device-specific template by filling in the template for display on the requesting device shows the claimed augmenting upon a request of data where the data is dynamic data since it changes according to each template, which again changes according to a device; communicating the generated data to the requesting device for display shows the claimed delivering)

Regarding claim 2, which is dependent on claim 1, Brid discloses authoring and storing the initial portion of the data and processing the stored initial portion to generate the at least the preferred and alternative versions of the initial portion of data ([0007]-[0008], [0010], [0025]).

Regarding claim 3, which is dependent on claim 1, Brid discloses that the dynamic data is generated from any one or more of the following: a database, a newsfeed, any suitable store of machine-readable data ([0029]).

Regarding claim 4, which is dependent on claim 1, Brid discloses determining with which version of the initial portion of the data the dynamically generated data fits most appropriately and augments that version with the dynamic data ([0029]: retrieving the appropriate device-specific template for generating the requested data shows the claimed determining).

Regarding claim 5, which is dependent on claim 1, Brid discloses using a model of the dynamic data in order to generate the versions of the initial portion of the data ([0025]: using different sets of data for generating template versions for different devices).

Regarding claim 6, which is dependent on claim 1, Brid discloses ensuring that there is at least one version of the initial version of the data that is suitable to augment with dynamic data to create data that is suitable to send to a data-handling device having the lowest capabilities that can receive data ([0032]-[0033]: provide a device-specific template suitable to augment with dynamic data (stock data) for a cell phone, which is a relatively small device having the relatively low capabilities that can receive data).

Regarding claim 7, which is dependent on claim 1, Brid discloses that the alternative versions of the initial portion of the data is structured to accommodate a different amount of dynamic data than the preferred version of the initial portion of the data ([0025]).

Regarding independent claim 9, Brid discloses:

- in the first stage generating an initial portion of the data in a preferred format and at least one alternative formats ([0007], [0008], [0025]: generating a first template, which is a preferred template, and a second template, which is an alternative template)

- in a second stage, upon receipt of a request for data, augmenting the initial portion in the one of the preferred format and one of the alternative formats with dynamically generated data ([0009]-[0010], [0012], [0029], [0035]: retrieving data from the data source and generating data for display on the identified device type from the device-specific template by filling in the template for display on the requesting device shows the claimed augmenting upon a request of data where the data is dynamic data since it changes according to each template, which again changes according to a device)

Regarding independent claim 11, Brid discloses:

- authoring the data by at least structuring the data in a manner which is independent of device on which the data is to be manifested ([0007]-[0009]: creating data by at least generating a first template which is device independent for display data)
- adapting the authored data to generate at least a preferred and an alternative adapted version of the authored data to make the data suitable for manifestation on a given class of device ([0007]-[0008]: generating a second template, which is an alternative version of the authored data to make the data suitable for display on a specific device type)
- storing the versions of the initial portions of the data ([0007], [0025], [0029]: caching the template versions)

- upon receipt of a request for data, augmenting at least one of the versions of the adapted data with dynamic data and delivering the initial portion of the data augmented with the dynamically generated data to at least one data-handling device ([0009]-[0010], [0012], [0029], [0035]: retrieving data from the data source and generating data for display on the identified device type from the device-specific template by filling in the template for display on the requesting device shows the claimed augmenting upon a request of data where the data is dynamic data since it changes according to each template, which again changes according to a device; communicating the generated data to the requesting device for display shows the claimed delivering)

Regarding claims 12 and 16, which are dependent on claim 11, Brid discloses determining with which version of the initial portion of the data the dynamically generated data fits most appropriately and augments that version with the dynamic data ([0029]: retrieving the appropriate device-specific template for generating the requested data shows the claimed determining).

Regarding claim 17, which is dependent on claim 11, Brid discloses ensuring that there is at least one version of the initial version of the data that is suitable to augment with dynamic data to create data that is suitable to send to a data-handling device having the lowest capabilities that can receive data ([0032]-[0033]: provide a device-specific

template suitable to augment with dynamic data (stock data) for a cell phone, which is a relatively small device having the relatively low capabilities that can receive data).

Regarding claim 18, which is dependent on claim 11, Brid discloses that the dynamic data is generated from any one or more of the following: a database, a newsfeed, any suitable store of machine-readable data ([0029]).

Regarding claim 19, which is dependent on claim 11, Brid discloses that the alternative versions of the initial portion of the data is structured to accommodate a different amount of dynamic data than the preferred version of the initial portion of the data ([0025]).

Claims 20 and 21 are for a computing device for performing method claim 1 and a network for method claim 1, and are rejected under the same rationale.

Claims 23-24 are for a device capable to perform method claim 1, and is rejected under the same rationale.

Claim 25 is for a computer readable medium containing instructions for performing method claim 1, and is rejected under the same rationale.

Claims 26, 27, and 28 are for a computer readable medium containing instructions for performing functions as in the device of claims 20, 21, and 23, and are rejected under the same rationale.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 8, 13, 15, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brid et al. (US 2002/0143822, 10/3/02, filed 1/31/01).

Regarding independent claim 8, Brid discloses:

- adapting an initial portion of the data in a preferred layout and at least one alternative layouts ([0007], [0008]: the data content is adapted in a first template, which is a preferred layout and a second template which is an alternative layout of data)
- upon a receipt of a request for data, adapting the initial portion in one of the preferred and the alternative layouts with dynamically generated data ([0035]: filling the retrieved data in the device-specific template and the formatted data is communicated to the requesting device for display shows that the data is adapted to one of the layout upon a data request)

Brid does not disclose that the first adapting is carried out in an off-line stage and the second adapting upon a receipt of a request for data is carried out in an on-line stage.

However, it would have been obvious to an ordinary skill at the time of the invention was made to have modified Brid to include performing the first adapting in an off-line stage and performing the second adapting in an on-line stage since it was well known that in the off-line stage, data is manipulated on a computer without connecting to the network or internet, and in the on-line stage, data is manipulated on a computer connecting to the network or internet. The second adapting, when upon a receipt of a request for data in a network suggests that the adapting is performed in an on-line stage whereas the first adapting is performed without upon any request.

Regarding independent claim 13, Brid discloses:

- authoring and storing an initial portion of the data ([0007]-[0009], [0025], [0029]: creating data by at least generating a first template which is device independent for display data and caching template data)
- processing the stored initial portion of the data to provide at least a preferred and an alternative layout version of the initial portion of the data, each layout version suitable to make the data suitable for handling by at least one of the at least two data-handling devices ([0007]-[0009], [0025]: generating a device-specific template, which is an alternative version of the stored data to make the data suitable for display on a specific device)
- storing the layout versions of the initial portions of the data ([0007]-[0009], [0025], [0029])

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- upon receipt of a request for data, determining with which of the preferred or alternative layout versions of the initial portion of the data the dynamically generated data fits most appropriately ([0029]: retrieving the appropriate device-specific template for generating the requested data shows the claimed determining) and augmenting at least one of the versions of the adapted data with dynamic data and delivering the initial portion of the data augmented with the dynamically generated data to at least one data-handling device ([0009]-[0010], [0012], [0029], [0035]: retrieving data from the data source and generating data for display on the identified device type from the device-specific template by filling in the template for display on the requesting device shows the claimed augmenting upon a request of data where the data is dynamic data since it changes according to each template, which again changes according to a device; communicating the generated data to the requesting device for display shows the claimed delivering)

Regarding independent claim 15, Brid discloses:

- structuring an initial portion of the data to provide at least a preferred and an alternative versions of the initial portion of the data, each version suitable to make the data suitable for handling by at least one of the at least two data-handling devices ([0008], [0025]: different template versions are structured to make data suitable to different devices where each template is considered an

initial portion of data since the requested data is provided based on each template)

- storing the versions of the initial portions of the data ([0007], [0025], [0029]: caching the template versions)
- upon receipt of a request for data, adapting one of the preferred or alternative version of the initial portions of the data by augmenting the initial portion of the data with dynamically generated data and delivering the initial portion of the data augmented with the dynamically generated data to at least one data-handling device ([0009]-[0010], [0012], [0029], [0035]: retrieving data from the data source and generating data for display on the identified device type from the device-specific template by filling in the template for display on the requesting device shows the claimed augmenting upon a request of data where the data is dynamic data since it changes according to each template, which again changes according to a device; communicating the generated data to the requesting device for display shows the claimed delivering)
- wherein, said structuring uses a model of the dynamic data in order to generate the preferred and alternative versions of the initial portion of data ([0025]: using different sets of data for generating template versions for different devices)

Claim 22 is for a server including means to perform method claim 8, and is rejected under the same rationale.

17. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brid et al. (US 2002/0143822, 10/3/02, filed 1/31/01) in view of Goodman (US 5,038,293, 8/6/91).

Regarding independent claim 10, Brid discloses:

- structuring an initial portion of the data to provide at least a preferred and an alternative versions of the initial portion of the data, each version suitable to make the data suitable for handling by at least one of the at least two data-handling devices ([0008], [0025]: different template versions are structured to make data suitable to different devices where each template is considered an initial portion of data since the requested data is provided based on each template)
- storing the versions of the initial portions of the data ([0007], [0025], [0029]: caching the template versions)
- upon receipt of a request for data, adapting one of the preferred or alternative version of the initial portions of the data by augmenting the initial portion of the data with dynamically generated data and delivering the initial portion of the data augmented with the dynamically generated data to at least one data-handling device ([0009]-[0010], [0012], [0029], [0035]: retrieving data from the data source and generating data for display on the identified device type from the device-specific template by filling in the template for display on the requesting device shows the claimed augmenting upon a request of data where the data is dynamic data since it changes according to each template, which again changes

according to a device; communicating the generated data to the requesting device for display shows the claimed delivering)

Brid does not disclose that:

- accepting payment from a user of one of said one or more data handling devices, the user requesting data
- said adapting is performed upon accepting the payment

Goodman discloses providing customized documents upon receiving a request from a user and upon receiving an indication of payment corresponding to the requested document (col 2, lines 10-18).

It would have been obvious to an ordinary skill at the time of the invention was made to have combined Goodman into Brid for delivering a requested data to a user requesting device upon accepting payment from a user at the requesting device and adapting data in a device-specific layout with dynamic data for a customized document upon such receiving of payment. This combination would offer a security in business environment when rendering data to a request party.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Shin et al. (US 5,557,787). Binding et al. (US 6,775,687).

Chernock et al. (US 6,806,887). Bickmore et al. (US 6,857,102).

Smith (US 6,957,383). Wang et al. (US 2002/0035579).

Mitchelmore (US 2002/0090934). Miyawaki et al. (US 2003/0236798).

Gaillard (US 2004/0059675). Yuknewicz et al. (US 2005/0172261).

Dyreson et al., Managing Versions of Web Documents in a Transaction-time Web Server, ACM 2004, pages 422-432.

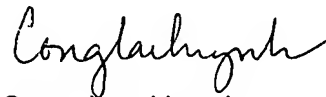
Fox et al., Adapting to Network and Client Variability via On-Demand Dynamic Distillation, ACM 1996, pages 160-170.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Thurs (9:00-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Cong-Lac Huynh
Primary Examiner
Art Unit 2178
6/22/07